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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1921.

No. 51

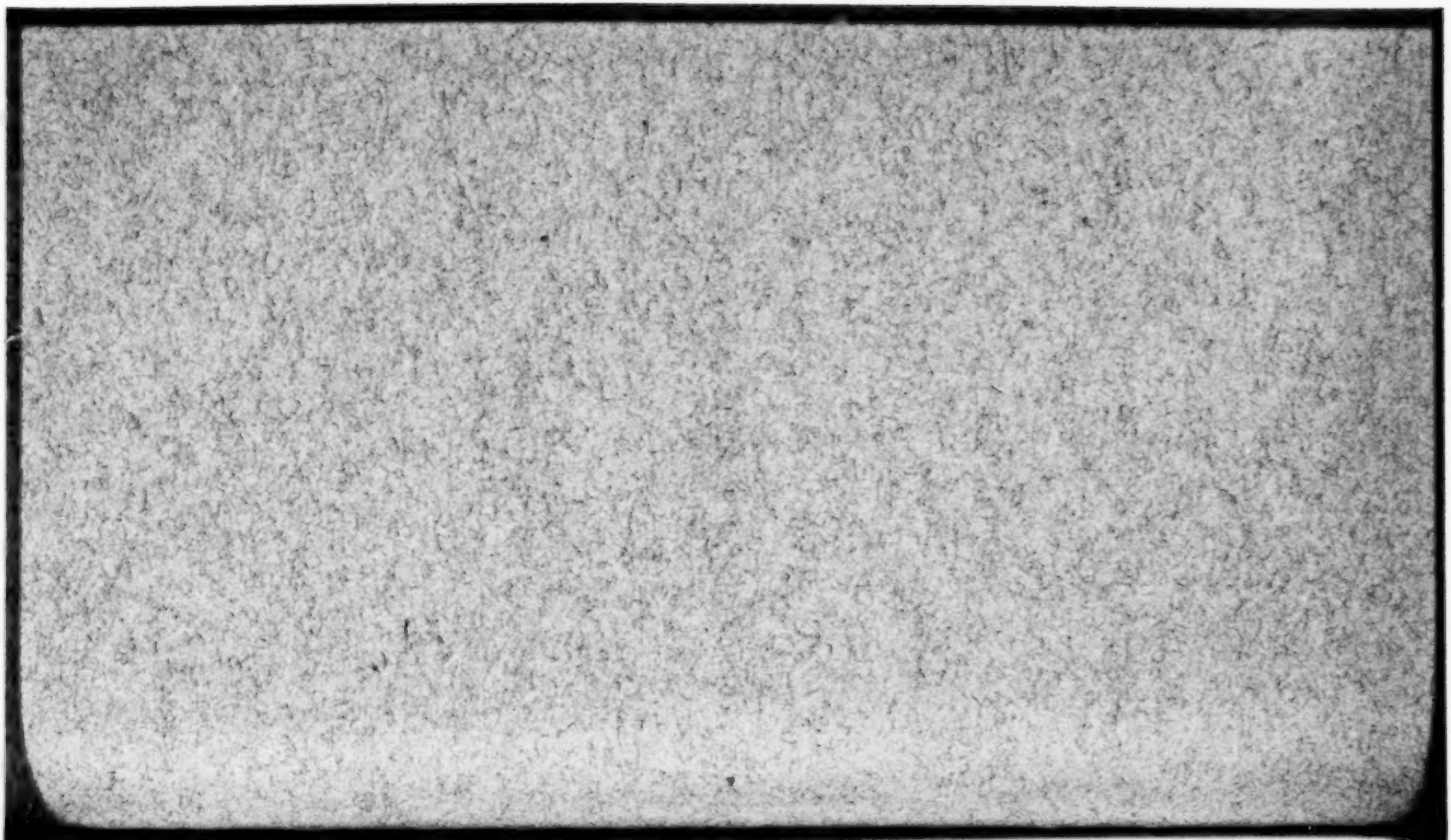
HERBERT L. HILDRETH, PETITIONER,

v.

JIM M. MASTORAS, RESPONDENT.

SUPPLEMENTAL BRIEF ON BEHALF OF RESPONDENT.

JOSEPH L. ATKINS,
W. A. ROBBINS,
Attorneys for Respondent.



SUBJECT INDEX

	Page
Occasion for Supplemental Brief	1-2
Reply to Q. I of Petitioner's Brief	3
Reply to Q. II of Petitioner's Brief	3-5
Reply to Q. III of Petitioner's Brief	5
Reply to Q. IV of Petitioner's Brief	5
It is a legal presumption that a later patent does not infringe an earlier patent. Reply at length to Q. V of Petitioner's Brief	5-21
Doctrine adopted by the Sixth Circuit	19-21
Mistake in regard to case of Ney v. Ney Mfg. Co., in Petitioner's Brief page 70	20
Case noted in support of request made in Respondent's Brief, pages 59-61	21-22
Items noticed for correction in Petitioner's Brief	22-24
Circuit Court of Appeals not bound by finding of facts by District Court in this case	8, 22
Firehau patent, No. 511,011, not mere paper patent	22-23
Defendant not a licensee under Dickinson patent	23
Petitioner substitutes bare assertion for proofs	23-24
Amendment precludes broad construction of Dickinson patent	24-26
Doubt raised by record of File Wrapper of Dickinson patent	26-27
Specific amendment restricting Dickinson patent	27-28

INDEX OF CASES

Page

Acme-Keystone Mfg. Co. v. Dearborn, 185 Fed. 503, 506 19

American Car & Foundry Co. v. Seeger Co., 178 Fed. 278 17

American Nicholson Pavement Co. v. Elizabeth, 4 Fisher'se Pat. Cas., 189, Fed. Cas. 312, p. 710 ... 15

American Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co., 123 Fed. 891-896 18

Autopiano Co. v. Amphion Piano Player Co., 186 Fed. 159, 166 17

Bates v. Keith, 82 Fed. 100-104 18

Benthall Mach. Co. v. National Mach. Corporation, 222 Fed. 918-933 18

Blanchard v. Putnam, 8 Wall., 75 U. S. 420-430; 19 L. Ed. 433-437 11

Boyd v. Janesville Hay Tool Co., 158 U. S. 260, 267; 39 L. Ed. 973, 976 ..... 12-13, 13, 17

Boyden Power-Brake Co. v. Westinghouse Air Brake Co., 70 Fed. 816, 833 16

Brooks v. Fiske, 15 How. 212, 232 4

Brown v. Selby, 2 Biss. 457, 470; Fed. Cas. 2030 15

Burden v. Corning, 2 Fish. Pat. Cas. 477, 497; Fed. Cas. 2143 ..... 15, 16

Byerley v. Standard Asphalt & Rubber Co., 189 Fed. 759, 761 17

Century Electric Co. v. Westinghouse Electric & Mfg. Co., 191 Fed. 350 17

Columbia Wire Co. v. Kokomo Steel & Wire Co., 143 Fed. 116-124 19

Corning v. Burden, 15 How. 252-272; 14 L. Ed. 683-692 ..... 10-11, 12

Crowe v. Oscar Barnett Foundry Co., 206 Fed. 164, 167 18

Dickinson v. Hildreth—Interference 27

Duff v. Sterling Pump Co., 107 U. S. 636; 27 L. Ed. 517 12

INDEX OF CASES—Continued

	Page
Electric Candy Mach. Co. v. Morris,156 Fed. 972-977.	19
Frank F. Smith Metal Window Hardware Co. v. Yates, 216 Fed. 361, 364. (Affirmed 2 C. C. A., 216 Fed. 359)	13, 18
Fried, Krupp-Aktien-Gesselischaft v. Midvale Steel Co., 191 Fed. 588-612	9
General Electric Co. v. Allis-Chalmers Co., 197 Fed. 197	17
Gillette Safety Razor Co. v. Durham Duplex Razor Co., 197 Fed. 574, 576	18
Griffith v. Shaw, 89 Fed. 313, 321	16
Herman v. Youngstown Car Mfg. Co., 191 Fed. 579-588	10, 19–20
Hildreth v. Auerbach, 223 Fed. 545, 547	3
Imperial Bottle Cap & Mach. Co. v. Crown Cork & Seal Co., 139 Fed. 312, 329	4, 16
Kokomo Fence Mach. Co. v. Kitselman, 189 U. S. 8-25; 47 L. Ed. 689-697	14–15
Miller v. Eagle Mfg. Co., 151 U. S. 186-208; 38 L. Ed. 121, 131	11, 17
Milwaukee Carving Co. v. Brunswick-Balke-Collender Co., 126 Fed. 171	16
Mitchell v. Tilghman, 86 U. S., 19 Wall. 287, 419; 22 L. Ed. 125, 144	4–5
National Harrow Co. v. Hanby, 54 Fed. 493, 494	15
National Mach. Corp. v. Benthall Mach. Co., 241 Fed. 72, 89	18
N. J. Wire Cloth Co. v. Buffalo Expanded Metal Co., 131 Fed. 265-296; affirmed Memorandum Dec., 135 Fed. 1021	16
Ney v. Ney Mfg. Co., 69 Fed. 405, 408	16, 20–21
Norton v. Eagle Automatic Can Co., 59 Fed. 137, 139	11, 16
Norton v. Jensen, 90 Fed. 415, 430	16
Oregon Woodenware Mfg. Co. v. Murray, 215 Fed. 744-747	18

Page

Putnam v. Keystone Bottle Stopper Co., 38 Fed. 234, 236 15

Ransome v. Hyatt, 69 Fed. 148, 149 15

Ries v. Barth Mfg. Co., 136 Fed. 850, 854 19

Robinson on Patents, Sec. 117 (Vol. I, p. 168) 4

Robinson on Patents, Sec. 896 (Vol. III, p. 53) 6

Robinson on Patents, Sec. 1027 (Vol. III, p. 274) 10

Ryder v. Schlichter, 126 Fed. 487-492 18

St. Louis Car Coupler Co. v. National Malleable Castings Co., 87 Fed. 885, 902 16

Sargent Mfg. Co. v. Woodruff, 5 Biss. 444; Fed. Cas. 12, 368 15

Simplex Elec. Heater Co. v. Leonard, 180 Fed. 763, 767 17

Spirella Co. v. Nubone Corset Co., 180 Fed. 470-474 19

Superior Skylight Co. v. August Kuhnla, Inc., 265 Fed. 282-286 18

Union Match Co. v. Diamond Match Co., 162 Fed. 148, 156 17

Union Steam Pump Co. v. Manton-Gaulin Mfg. Co., 272 Fed. 773-775 22

United States Fastener Co. v. Meyers, 145 Fed. 536. 17

Weber Electric Co. v. E. H. Freeman Elec. Co., U. S. Supreme Court, No. 273, Oct. Term, 1920. L. Coop. Advance opinions, 705-790 24-25

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1921.

No. 51

HERBERT L. HILDRETH, PETITIONER,

v.

JIM M. MASTORAS, RESPONDENT.

SUPPLEMENTAL BRIEF FOR RESPONDENT, JIM M. MASTORAS, OFFERED IN REPLY TO BRIEF FOR PETITIONER.

OCCASION PRESENTED FOR SUPPLEMENTAL BRIEF.

This case, formerly No. 333 of October Term, 1920, was, under repeated advices which we received from the Clerk of the Court, expected to be reached for argument the latter part of the last week in April, 1921. Acting upon such advices, one of counsel for Respondent made the journey from Portland, Oregon, to Washington, D. C., and was present in court on April 25th., 1921, only to learn that the case would go over for hearing to the next term.

The postponement of the hearing in this case works great hardship upon Respondent. As was brought to the attention of the Court in Motion on behalf of Respondent to advance the case on the

docket, presented Monday, December 6, 1920, the potential value of Respondent's patent involved in this suit is very materially affected thereby. Moreover, the very considerable expense incurred by Respondent in securing attendance of counsel in Washington to argue the case in April last, as aforesaid, has utterly exhausted his pecuniary resources, which this litigation had already, as the record shows, reduced to the lowest ebb.

If, therefore, as he apprehends he will be, he is unable to be represented by counsel in person at the hearing of this case, the necessity for amply presenting all points of argument by brief becomes indispensible.

Furthermore, the Brief for Petitioner was not filed until April 21, 1921, which was not, as we understand it, in compliance with the Rule, if the case had been heard, as was expected, during the week beginning April 25th.

Brief for Respondent was held open to the last moment in order that there might be embodied in it reply to Brief for Petitioner; but it finally became necessary to print it without any information of the contents of Petitioner's Brief.

Wherefore, Counsel for Respondent beg to present this supplemental Brief by way of reply to said Brief of Petitioner.

QUESTIONS RAISED IN BRIEF FOR PETITIONER.

Five "Questions in the case" are presented in Brief for Petitioner (page 6) and are identified,

respectively, by numerals I to V, inclusive. That method of identification will be followed in the following pages.

QUESTION I.

This question may be briefly stated to be what is the effect, by way of limitation, on the Dickinson patent, the patent sued upon, of the Firchau patent (Rec. pp. 266-270—errors in printed record being noted, p. 13, Respondent's Brief). Discussion of this question appears in Respondent's Brief, pages 13, 14, 51 and 52. The conclusion of the Circuit Court of Appeals in this case (Record, pp. 335-336) is set forth in the following words:

> "It is thus seen that Dickinson did not get very far beyond Firchau, and that in his device, as in Firchau's, the candy is alternately massed and stretched."

Said conclusion is supported by that of Judge Learned Hand, in Hildreth v. Auerbach, 223 Fed. 545-547.

QUESTION II.

Whether the machine shown in the Dickinson patent is inoperative for the purpose for which it was intended and therefore the patent is invalid, or of narrow scope, because the alleged invention is lacking in utility?

The foregoing statement fairly begs the question when it sets up the question to be whether the Dickinson patent is inoperative *for the purpose*

for which it was intended. The real question is, what was the purpose for which it was intended? It was doubtless intended, in a certain sense, to pull candy. But even if the Dickinson machine be operative, it does not follow that respondent's machine infringes. It still remains to be shown that Respondent attains the same end by substantially the same means.

Respondent contends that he attains both an end different from that attained by Dickinson, and by different means. The difference of the means is pointed out under caption V of his Brief (Respondent's Brief, pp. 37-43).

There are certain principles of patent law controlling upon this point which are recognized to be elementary, as shown, for instance, in the following cases:

> "Things are not necessarily equivalents because they produce the same results."
>
> *Brooks v. Fiske*, 15 How. 212-232 (p. 221).

> "Identity of end (Robinson on Pat., Sec. 117) is no proof of identity of means."
>
> *Imperial Bottle Cap and Mach. Co. v. Crown Cork and Seal Co.*, 139 Fed. 312-329 (p. 323). (4 C. C. A.).

> "Two things are not the same, under the patent law, when one is, in practice, substantially better than the other in a case where the second improvement is not gained by the

same means or known mechanical equivalents. (Curt. Pat. 4th Ed., Sec. 330)."

Mitchell v. Tilghman, 86 U. S., 19 Wall., 287-419; 22 L. Ed., 125-144 (p. 144).

QUESTION III.

This question, as it is stated in Petitioner's Brief, has no bearing on the question of infringement raised. Even though a difference in principle between the Dickinson and the Firchau patents does exist, it does not follow that Respondent's patent infringes Dickinson.

QUESTION IV.

This question is the only one that goes to the specific ground of complaint set up (see Respondent's Brief, p. 2) in the Petition for Certiorari.

Having been set up therein, the question is anticipated and answered in Respondent's Brief (pp. 17-19), the answer being (ib. p. 18) that the Circuit Court of Appeals, did not, in this case, use the language attributed to it, and did not at all base its decision upon any proposition materially resembling that set up as ground of complaint in the petition.

QUESTION V.

This question was noticed in Respondent's Brief (p. 19), but as it is not included specifically in the petition for certiorari filed in this case, it was formerly regarded as of minor importance and as so regarded by the court below.

Upon further consideration, however, this very question appears to be the probable ground upon which the certiorari was granted. That this is the correct view is enforced by the length at which the point is argued in Petitioner's Brief (pp. 68-77).

We, therefore, if it please the Court, beg to submit argument in support of the following proposition of law, to wit:

IT IS A LEGAL PRESUMPTION THAT A LATER PATENT DOES NOT INFRINGE AN EARLIER PATENT.

Upon careful examination of all authorities which we have been able to discover by independent search, or which the Brief for Petitioner sets up, we find the doctrine fundamentally recognized in the language employed by Professor Robinson, as follows:

> "Every patent is *prima facie* evidence of the novelty of the invention which it claims, and every patented invention is thus presumed to be essentially different from every other until the contrary appears."
>
> Rob. Pat. Sec. 896 (Vol. III, p. 53).

The said author first observes, in the section quoted, that the issue of a later patent does not conclusively establish the absence of identity, which is sound, since there are few presumptions of law that are conclusive. The said section, in closing, contains also these words:

"but when this presumption has been overcome, through the application of the tests by which identity must in all cases be finally determined, the later patent affords no protection," etc.

The author extends the application to an extreme case in which two patents apparently are entirely identical; but his language applies, *a fortiori*, to a case like the present one in which there is no allegation of entire identity. In the case at bar, some diversity between the two patents involved is admitted. All that petitioner claims for the Dickinson patent is that it bears such generic relationship to Respondent's patent as to dominate it.

The case at bar at once demonstrates, it is submitted, both the soundness of the presumption invoked, and the reason and justice in which that presumption is founded.

The presumption, in the present case, for instance, forcibly enjoins upon the Court the necessity for "the application"—to repeat the language of the eminent writer just quoted—"of the tests by which identity must in all cases be finally determined."

Petitioner is consistent in resisting the application of the presumption which the court below applies, because he has failed to produce evidence to meet "the tests by which identity must in all cases be finally determined." The inference is strong that he could not do so.

His failure so to do is made conspicuous by the existence of the presumption. The court below has nevertheless applied the tests, independently of the presumption, and has decided that there is no infringement. This is not a case in which a party seeks by substitution of presumption of law for proof to make his case. On the contrary, the Court of Appeals below based its decision not upon bare inference, but upon evidence before it of Respondent's machine presented to it in actual operation. By the same token, the judgment of the Circuit Court of Appeals is, as will be again hereinafter adverted to, untrammelled by findings of fact by the District Court below. Each court had before it, the same original proof afforded in Respondent's actual machine in operation.

CONFLICT OF OPINION RESPECTING THE LEGAL PRESUMPTION THAT A LATER PATENT DOES NOT INFRINGE AN EARLIER PATENT.

It appears to be correctly set out in Brief for Petitioner, that, in respect to the rule as laid down by the Circuit Court of Appeals for the Ninth Circuit, the Circuit Court of Appeals for the Sixth Circuit is the only one that denies the rule. Substantial reconcilability if not perfect unanimity of opinion in support of the rule exists among all the courts, excepting those of the Sixth Circuit.

The list of cases contained in Brief for Petitioner is taken to be correct so far as it goes, but is incomplete, as will appear upon comparison therewith of the cases tabulated below.

A distinction is therein attempted to be drawn between the rule in question and the well recognized rule that there is the presumption of dissimilarity between the respective subjects matter of two patents, but we contend they are, for reasons following, in effect, the same. The rule is elementary and established beyond controversy, that infringement involves substantial identity between two or more objects of invention. (For authorities see Respondent's Brief, p. 21).

Ergo, as between two such objects, where diversity exists, there can be no infringement. That is to say, proof of infringement requires proof of substantial identity. It follows, therefore, that the presumption of diversity, between their respective subjects matter, raised by the grant of two patents, carries with it the presumption of non-infringement.

The presumption last named is also fortified by the elementary presumption of innocence in respect to an alleged tort.

Infringement * * * is a tort or wrong, the burden of establishing which as in all torts, clearly rests on those who charge the wrong.

Fried, Krupp Aktien-Gesellschaft v. Midvale Steel Co., 191 Fed. 588-612, p. 591.

REVIEW OF DECISIONS.

If the two presumptions, which may be briefly stated to be, that of non-infringement of an earlier by a later patent, and that of diversity between

two patents, are found in effect, to be substantially identical, as they are believed to be, recognition of that as a fact will reconcile the decisions of all the courts, since even the courts of the Sixth Circuit accept the validity of the last named presumption.

Herman v. Youngstown Car Mfg. Co., 191 Fed. 579-588, p. 585.

See Robinson on Patents, Vol. III, Sec. 1027.

The following list is believed to include all the most important cases in point, substantially from the inception of the doctrine to the present time. In said list no distinction is made in respect to the two presumptions as noted in the preceding paragraph, because, for reason therein stated, there is no distinction to be made.

This Court has repeatedly passed upon the question under consideration.

In Corning v. Burden, (15 How. 252-272; 14 L. Ed. 683-692) Justice Grier, delivering the opinion of the Court, and considering that the plaintiff is entitled to the benefit of the *prima facie* presumption is favor of the validity of his patent, says (p. 271):

> "And if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor * * * but if the plaintiff's patent in a doubtful case may have some

> weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat.* The parties should contend upon an equal field, and be allowed to use the same weapons."

Whereupon, the judgment of the court below was reversed.

In the case at bar, the application of the doctrine simply puts the parties upon equal footing, leaving complainant to such proofs as he might have offered but did not offer of his allegation of infringement.

It has been held in Norton v. Can Co., 59 Fed. 137-139 (p. 138), that the decision in Corning v. Burden was overruled in Blanchard v. Putnam, 8 Wall. 75 U. S. 420-430; 19 L. Ed. 433-437; but, the facts in that case, it is submitted, support no such conclusion. On the contrary, Blanchard v. Putnam was an action at law on the case. Defendants, having pleaded not guilty, sought at the trial to introduce and did introduce in evidence a later patent without the notice to plaintiffs required by law.

It was the admission of that evidence that was held to be error in the court below, and thereupon its judgment was reversed.

In the case entitled Miller v. Eagle Manufacturing Co., 151 U. S. 186-208, p. 208; 38 L. Ed. 121-131, this Court held that the issue of a later patent to defendant "creates a *prima facie* presumption of

a patentable difference from that" of complainant, citing Corning v. Burden as last noted, and Duff v. Sterling Pump Co., 107 U. S. 636 (27 L. Ed. 517).

The report of the case last noted from 107 U. S., is meagre, but shows that the complainant sued upon one patent and the defendant operated under a later patent. The opinion recites (27 L. Ed., page 517): "The (lower) court entered a decree declaring that the equities were with the defendant and dismissing the bill," and affirmed the decree of the lower court.

The cases, therefore, not only go to sustain the presumption for which we are contending, but also, we submit, to establish, as a corrollary thereto, that presumption of a patentable difference, and presumption of non-infringement are, in effect, identical.

In the case entitled Boyd v. Janesville Hay Tool Co., 158 U. S. 260-267; 39 L. Ed. 973, 976, this Court, in its opinion, p. 262, adopts the words of Mr. Justice Strong in American Nicholson Pavement Co. v. Elizabeth, 4 Fisher's Pat. Cas. 189 (Fed. Cas. 312, p. 710) as follows:

> "The grant of the (later) letters patent was virtually a decision of the Patent Office that there is a substantial difference between the inventions" (those of the earlier and the later patents). "It raises the presumption that ac-

> cording to the claims of the later patentees, this invention is not an infringement of the earlier patent."

The said decision is in itself regarded as amply sufficient to settle both questions, and to substantially identify the effect of the presumption of non-infringement of an earlier by a later patent, with the rule that the grant of two patents raises the presumption of the existence of a patentable difference between them.

Judge Hand, in a recent case, Frank F. Smith Metal Window Hardware Co. v. Yates, 216 Fed. 361-364, (affirmed by the Circuit Court of Appeals, Second Circuit, 216 Fed. 359-361) says:

> "The presumption arising from the subsequent patent to Yates that there is no infringement is certainly supported by authorities. (Boyd v. Janesville)" (*supra.*)

Judge Hand's decision is made notwithstanding a full consideration by him of facts alleged to negative existence of the presumption of infringement in the subsequent issue of a patent. Such facts only serve to direct attention to the inference that different grounds than those considered must be sought as the true support for the presumption.

We trust it will not be regarded as too great a digression, to observe that the case at bar forcibly illustrates the potential importance in some

cases of the presumption in question to the ends of justice. In this case, for instance, where mere delay of final adjudication is vital, if the contention of petitioner that the Court of Appeals erred in recognizing the presumption should prevail, he, after having had his day in court, might hope to enjoy another opportunity to make the case he has failed to make and which he must make in order to recover.

In the case at bar it is denied and has not been shown that petitioner's machine even so much as produces the same results as his opponent's machine was demonstrated to produce, much less that in the two machines the same results are produced by means substantially identical. The point contended for, and even that not one vital to the support of the decision of the Court of Appeals below, is simply that in the absence of proof sufficient to overcome it, the presumption of non-infringement prevails.

The last decision made by this Court upon the question under discussion is, so far as we have discovered, in the case entitled Kokomo Fence Machine Co. v. Kitselman, 189 U. S. 8-25; 47 L. Ed., 689-697.

That decision (p. 23) appears to fully sustain the rule, and upon the very premise we urge to be controlling, although the courts of the Sixth Circuit appear to have overlooked it, namely: "The presumption from the grant of letters patent is that there was a substantial difference between

the inventions." The case there under consideration corresponds, in respect to relationship of the patents, to the one at bar.

LIST OF CASES IN WHICH THE COURTS BELOW FOLLOW THE RULE.

The grounds for its following of the rule by the Circuit Court of Appeals for the Ninth Circuit, and to which it has consistently adhered, are clearly set out in the decision:

Ransome v. Hyatt, 69 Fed. 148-149.

For that reason said case is selected, by way of example of the line of decisions in the Ninth Circuit, and is set at the head of the list. After it, the decisions noted follow in the order of their several indicated dates of rendition.

American Nicholson Pavement Co. v. Elizabeth, supra (1870), followed in

Sargent Mfg. Co. v. Woodruff, 5 Biss. 444; Fed. Cas. 12, 368 (1873).

Putnam v. Keystone Bottle Stopper Co., 38 Fed. 234-236 (Cir. Ct., Penna., 1889).

National Harrow Co. v. Hanby, 54 Fed. 493-494 (Cir. Ct., N. Y., Judge Coxe, 1893).

Citing Brown v. Selby, 2 Biss. 457, p. 470, Fed. Cas. 2030, pp. 429-434 (Cir. Ct., Ills., 1871). Also, Burden v. Corning, 2 Fish. Pat. Cas. 477-497; Fed. Cas. 2143, wherein (F. C., p. 710,) the rule is followed. (Cir. Ct., N. Y., before Mr. Justice Nelson and Hall, D. J., 1864.).

Burden v. Corning, last *supra*, is referred to in Norton v. Eagle Automatic Can Co., 59 Fed. 137-139, as having been overruled in Blanchard v. Putnam; but this inference appears upon its face, it is submitted, to be unsound.

Norton v. Eagle Automatic Can Co., 59 Fed. 137-139 (Cal. D. C., 1893).

Ney v. Ney Mfg. Co., 69 Fed. 405-408, pp. 407-8 (6 C. C. A., Taft, C. J., 1895).

Boyden Power-Brake Co. v. Westinghouse Air Brake Co., 70 Fed. 816-833, Syl. 2 (4 C. C. A., 1895), affirmed by the Supreme Court in 170 U. S. 537; 42 L. Ed. 436.

St. Louis Car Coupler Co. v. Natl. Malleable Castings Co., 87 Fed. 885, 902 (6 C. C. A., 1898).

Griffith v. Shaw, 89 Fed. 313-321 (Cir. Ct., Iowa, 1898).

Norton v. Jensen, 90 Fed. 415-430 (9 C. C. A., 1898).

Milwaukee Carving Co. v. Brunswick-Balke-Collender Co., 126 Fed. 171 (9th Circuit, 1903).

N. J. Wire Cloth Co. v. Buffalo Expanded Metal Co., 131 Fed. 265-296, p. 268, (Cir. Ct., N. Y., 1904). Affirmed, memorandum decision, 135 Fed. 1021 (2 C. C. A., 1905).

Imperial Bottle Cap & Mach. Co. v. Crown Cork & Seal Co., 139 Fed. 312-329, p. 329, (4 C. C. A., 1905).

United States Fastener Co. v. Meyers, 145 Fed. 536-538, p. 537 (Cir. Ct., N. Y., 1906).
Union Match Co. v. Diamond Match Co., 162 Fed. 148-159, p. 156 (8 C. C. A., 1908).
Simplex Elec. Heater Co. v. Leonard, 180 Fed. 763-767, (Cir. Ct., N. Y., 1910).
Autopiano Co. v. Amphion Piano Player Co., 186 Fed. 159-166, (2 C. C. A., 1911).

It is noteworthy that the opinion of Judge Hand in the court below, is adopted, *in extenso,* by the Appellate Court, in the case last noted.

Byerley v. Standard Asphalt & Rubber Co., 189 Fed. 759-761 (Cir. Ct., N. J., 1911).

In this case Judge Cross (p. 761), says:

> "Such presumption in favor of the subsequent patent exists, until overcome by proof." Citing Boyd v. Hay Tool Co., *supra;* Miller v. Eagle Mfg. Co., *supra;* Ran(d)some v. Hyatt, *supra;* and, also Am. Car & Foundry Co. v. Seeger Co., 178 Fed. 278, which was decided by Judge Cross below, and affirmed by the Court of Appeals for the Third Circuit.

This is precisely respondent's contention.

Century Electric Co. v. Westinghouse Electric & Mfg. Co., 191 Fed. 350 (8th Cir., 1911).
General Electric Co. v. Allis-Chalmers Co., 197 Fed. 197 (D., N. J., 1912).

Gillette Safety Razor Co. v. Durham Duplex Razor Co., 197 Fed. 574-576 (D., N. J., 1912).

Crowe v. Oscar Barnett Foundry Co., 206 Fed. 164-167 (D., N. J., 1913).

Oregon Woodenware Mfg. Co. v. Murray, 215 Fed. 744-747, p. 745 (D., Wash., 1914).

Frank F. Smith Metal Window Hardware Co. v. Yates, Supra. (2 C. C. A., 1914).

Benthall Mach. Co. v. National Mach. Corporation, 222 Fed. 918-933, p. 932 (D., Va., 1915).

Affirmed as to rule in question by Circuit Court of Appeals, in National Mach. Corp. v. Benthall Mach. Co., 241 Fed. 72-89.

Superior Skylight Co. v. August Kuhnla, Inc., 265 Fed. 282-286, p. 286 (D., N. Y., 1920).

IN THE DECISIONS LISTED HEREUNDER, THE PRESUMPTION IS RECOGNIZED BUT CONSIDERED TO BE INAPPLICABLE TO THE FACTS OF SOME CASES.

"Parties in equilibrio."

Bates v. Keith, 82 Fed. 100-104, p. 103 (Cir. Ct., Mass., 1897).

American Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co., 123 Fed. 891-896, p. 894 Cir. Ct., N. Y., 1903).

Ryder v. Schlichter, 126 Fed. 487-492, p. 490, (3 C. C. A., 1903).

"The facts are to be taken from the proofs."

Ries v. Barth Mfg. Co., 136 Fed. 850-854, (7 C. C. A., 1905).

Operation of presumption of non-infringement negatived by proof of substantial identity in fact.

Columbia Wire Co. v. Kokomo Steel & Wire Co., 143 Fed. 116-124, p. 123 (7 C. C. A., 1905).

Court having found infringement, defendant's operation under subsequent patent is no defense.

Electric Candy Machine Co. v. Morris, 156 Fed. 972-977, p. 976 (Cir. Ct., Mo., 1905).

Spirella Co. v. Nubone Corset Co., 180 Fed. 470-474 (Cir. Ct., Penna., 1910).

In this case the Court says, p. 471: "An examination of the patents shows beyond doubt that defendant's stay is a mere evasion of complainant's patents."

Second patent "does not necessarily negative infringement."

Acme-Keystone Mfg. Co. v. Dearborn, 185 Fed. 503-506, p. 505 (2 C. C. A., 1911).

THE DOCTRINE ADOPTED BY THE SIXTH CIRCUIT.

It is deemed unnecessary to attempt to list all of the decisions rendered by the courts of the Sixth Circuit; and Herman v. Youngstown Car

Mfg. Co., 191 Fed. 574, as stated in Petitioner's Brief, pp. 73-75, together with others set out on the page last noted, may be accepted to show clearly the erroneous opinion, as it is conceived to be, to which the Court of Appeals of the Sixth Circuit is committed.

But we invite the attention of this Court particularly to the opinion rendered in that Circuit Court of Appeals by Mr. Chief Justice Taft, then Circuit Judge, in the case of Ney v. Ney Mfg. Co., *supra*. That case is cited by the Court of Appeals in its decision in the case at bar, but is alleged in Petitioner's Brief (p. 70) to be one of four relating "solely to the presumption of novelty."

In that assertion counsel for Petitioner appear to be mistaken. In that case Judge Taft said:

> "In American Nicholson Pavement Co. v. City of Elizabeth, 4 Fish. Pat. Cas. 189 (Fed. Case No. 312 in footnote) Mr. Justice Strong said: 'The grant of the letters patent was virtually a decision of the Patent Office that there is a substantial difference between the inventions. It raises the presumption that; according to the claims of the latter patentees, this invention is not an infringement of the earlier patent.'"

Omitting the remainder of the quotation from Mr. Justice Strong's decision, because it is to the same purpose, we deem it sufficient to quote the

words that immediately follow it, wherein Judge Taft says:

> "This language has full application to the case at bar, for, though the patents were not pending in the office at the same time, the presumption from the granting of the second patent, in view of the previous issue of the first, would not seem to be different."

It is in view of the decision last quoted, as well as in view of the fact that the existence of the presumption urged was recognized by Mr. Justice Strong and has been followed by all the courts of the land (one circuit alone excepted), so far as we have been able to discover, that we maintain that the presumption is good and ought to stand.

Under caption VI, "Brief on behalf of Respondent," pp. 59, 60, 61, we made bold to ask this court, should it decide in favor of Respondent, to render a decision which will dispose of any question of infringement, either of the Dickinson patent or of any other of Petitioner's patents that are admittedly subordinate thereto.

Since that Brief was written, a decision has been rendered by Judge Hale in the U. S. District Court for the District of Maine, supported by a decision, quoted from a case decided in the District Court at Boston by Judge Anderson, which is believed amply to justify in part, and altogether in principle, our said application for relief against threatened litigation. Judge Hale said:

> "I agree with Judge Anderson that a litigant should not be allowed to treat the nine claims of a patent as nine patents; that when defeated on some of his claims, he should not be permitted to go against the same defendant and try out the other claims against the device alleged to be infringed at the time the original suit was brought,"

—with further language to like purport, to distinguish from the established doctrine that, for some other purposes, each claim is, in effect, a separate patent.

> *Union Steam Pump Co. v. Manton-Gaulin Mfg. Co.*, 272 Fed. 773-775, p. 775.—Advance Sheets.

ITEMS NOTICED FOR CORRECTION IN PETITIONER'S BRIEF.

We deny that the Court of Appeals was bound by the findings of fact by the District Court (Petitioner's Brief, pp. 43 to 53) on the hearing *de novo* had in the case, and we particularly call the attention of this Court to the fact that the Court of Appeals had before it defendant's machine in operation as well as complainant's alleged model and the Firchau machine.

On page 19 of Petitioner's Brief, second paragraph, it is stated, in italics: "This patent (Firchau 511,011) is a mere paper patent resurrected solely for the purpose of this suit."

This statement is without any evidence of foundation in fact to support it, and is not entitled to any consideration.

On page 10 of Petitioner's Brief, also indexed, appears in bold faced type the heading "DEFENDANT A LICENSEE UNDER THE DICKINSON PATENT."

This display might, without examination, lead to a false conclusion. In point of fact, defendant was at one time a licensee under Petitioner's patents generally; but when he acquired the Langer patent he began to operate under a patent different from any that Hildreth owned, and surrendered his license, as he had a right to do, when he ceased to use a Hildreth machine. The grant of the Langer patent recognized its subject matter to be a distinct advance over the preexisting art.

The relationship of licensee which Respondent at one time bore to the Petitioner was prior to his operation under the Langer patent, and has no bearing upon the case at bar, except to show that Respondent has never recognized the Langer patent to be a subordinate patent.

Along the same line of argument, Petitioner's Brief, throughout, takes for granted that which the burden is upon him to prove, and puts forward bare assertion in place of proof.

For example, Petitioner's Brief, under the headings: "Candy Pulling" (pp. 10-12); "The Machine of the Dickinson Patent" (pp. 13, 15-17); "Advantages Resulting from Dickinson's Invention"

(pp. 17, 18); "The Dickinson Patent a Broad Patent" (pp. 30-32); "Dickinson Patent Not a Mere Paper Patent" (p. 32); "Identity of the Movements of the Dickinson and Langer Machines" (beginning p. 60), the bold assumption is, in each instance, made that the proposition has been established that by proof which the patent law demands, and that Dickinson is entitled, not to a patent of some restricted scope, but that he is entitled to have his patent construed to a breadth far exceeding any scope apparent upon it face, or beyond anything specified in it.

Such assumption begs every question involved in the case, and can hardly serve to cloud the real issues. Nevertheless, we deem it proper to point out that it is assumption and nothing more.

In respect, particularly, to the heading last noted (p. 60) the attention of the Court is invited to discussion under Caption V of Respondent's Brief, pp. 37-43, and under Caption VI thereof, pp. 43-53.

AMENDMENT PRECLUDES BROAD CONSTRUCTION OF DICKINSON PATENT.

In a recent case brought before it on certiorari—Weber Electric Co. v. E. H. Freeman Electric Co., Lawyers' Cooperative Advance Opinions, Oct. Term 1920 (No. 273), 705-709—this Court confirms the well established rule that where he accepts a restricted claim in order to obtain a patent, "the patentee may not by construction, or by resort to

the doctrine of equivalents, give to the claim the larger scope which it might have had" without amendment (ib. 709).

The case at bar comes under that rule. Because, when Dickinson's original claims 1 and 2 were rejected (Record, p. 213) by the Patent Office, he, by amendment filed July 12, 1906, cancelled those claims (Record, p. 214) and accepted the then subsisting claim 3, substantially, as claim 1 of his patent.

By the said amendment he requested postponement of allowance of his application pending decision in an interference described as Dickinson against Hildreth, but not identified by Interference number.

Afterwards, by amendment filed July 30, 1906, Paper No. 13, (Record, pp. 215 to 219) Dickinson reinstated, without any apparent ground for so doing, the claims 1 and 2 which he had, by his preceding amendment (Paper No. 12, as aforesaid) cancelled. The claims formerly 1 and 2, and previously cancelled, become claims 10 and 11 in amendment of July 30, 1906, said claim 11 being amended by the addition to claim 2, line 2 (Record, p. 200), of the words: "more than two" before "pins." Even so, Firchau shows, in effect, three pins (*vide* Respondent's Brief, p. 51, lines 17 to 22).

It is, we submit, inconceivable that an applicant could formally cancel and surrender two claims on July 12th, and then, on the 30th day of the

same month, be permitted, *tacitly*, to restore the claims he had surrendered after they had been involved for five years in an interference (see Record, p. 206). Some explanation of such reversal of its action by the Patent Office is due the dignity of this Court, but none is offered.

DOUBT RAISED BY RECORD OF FILE WRAPPER OF DICKINSON PATENT.

This point was raised before his Honor, Judge Wolverton, at the trial, but was by him dismissed with scant consideration (Record, p. 20) on the ground that the patent does contain original claims 1 and 2 under different numbers, to wit 10 and 11.

It is insisted that such an extraordinary circumstance demands explanation, and cannot be ignored. Nevertheless, in any view of it, the amendment of claim 11, as compared with original 2, brings it under the rule in the case last cited. There is no explanation of the action of the Patent Office to be found anywhere in the record, unless the explanation be that the allowance of claims 10 and 11 was by inadvertence, as it would certainly appear to have been from the language of the amendment of July 30, 1906, aforesaid, as follows:

"REMARKS:

"We have just been notified by the office that the divisional application, Serial No. 248,765, has been returned to the Primary Examiner, the interference between Dickinson and Hildreth having been terminated by the concession of priority filed by Hildreth. We are accordingly amending this application by the addition to it of the claims which were the issues of the interference No. 25,510, Dickinson v. Hildreth, also by the addition of the two claims which were in the Dickinson divisional application, but were not in the interference." (Record, p. 218.)

The paragraph last quoted would seem to indicate that of the fifteen claims introduced by the said amendment of July 30, 1906, thirteen of them were involved in interference No. 25,510, and, besides those, "two claims which were in the Dickinson divisional application, but were not in the interference."

But claim 10 and claim 11, substantially, were in one interference, and upon rejection (Record, p. 213) were cancelled (Record, p. 214).

So, the "explanation" does not explain.

SPECIFIC AMENDMENT RESTRICTING DICKINSON PATENT.

If it be urged, in the face of such a defective record, that claim 11 is not identical with original claim 2, that is a confession of its amendment,

which must, under the decision last cited, defeat Petitioner's contention for a broad construction of the patent in suit, and of claim 1 thereof, in particular. That is to say, the presence of claims 10 and 11 in the patent, so far from aiding Petitioner's contention, requires a construction of claim 1 which shall differentiate it from claims 10 and 11, the plain words of differentiation in claim 1 being "a specified relative in and out motion of these parts." The uncertainty, nevertheless, of the elements intended to be designated by "these parts" is pointed out under caption IV, beginning page 34 of Respondent's Brief.

Attempt to reply, seriatim, to each argument presented in Petitioner's Brief, would, it is believed, add little, except in respect to form, to what was set forth by anticipation in Respondent's original brief, and would be more likely, through repetition, rather to burden than to relieve the Court.

We are content, therefore, to add to what is contained in our former brief the foregoing by way of supplement.

Respectfully submitted,

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